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Remarks

Claims 11-13, 15, 16, and 18-22 are pending, claims 1-10, 14 and 17 having been cancelled. Claim 11 is the only independent claim. Reconsideration and reexamination of the application is respectfully requested.

In response to the restriction requirement, applicant herewith elects the invention I defined by the Examiner as drawn to a rubber composition. The claims encompassing the elected invention are all of pending claims 11-13, 15, 16, and 18-22

It is submitted that the claimed invention is novel and non-obvious over the prior art of record.

In fact, both **Barma** and **Fujii *et al.*** do not teach nor fairly suggest, to a person having ordinary skill in the art, a vulcanizable rubber comprising at least one hydroxyl acrylic resin. Specifically, the cited **Barma** includes no disclosure or fair suggestion of a hydroxyl acrylic resin, and the cited **Fujii *et al.*** while disclosing general "acrylic acid" substances, also does not disclose nor fairly suggest a hydroxyl acrylic resin as specifically required in applicant's independent claim 11.

Applicant's claimed invention achieves advantageous results that are surprising and unexpected over the teachings of the prior art of record.

In particular, the claimed hydroxyl acrylic resin in the vulcanizable rubber provides an efficient and effective adhesion function when the rubber is coupled for example with polyurethane, as in the case of shoes having a tread sole in such claimed vulcanizable rubber and a mid-sole in polyurethane. The hydroxyls in the acrylic resin of the vulcanizable rubber provide an excellent coupling with for example free isocyanate groups present in the polyurethane, and such hydroxyls in the acrylic resin also remain unaltered even at high vulcanization temperatures of the rubber. Applicant submits that these combined advantageous results are surprising and unexpected over the teachings

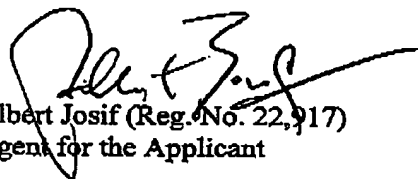
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of the prior art of record, which offers no teachings or suggestions to a person having ordinary skill in the art to arrive at the claimed combination for achieving such advantageous results.

Finally, note that with regard to the previous provisional obviousness-type double patenting rejection based upon co-pending Application No. 10/450,567, in the instant application the claims are directed to a vulcanizable rubber product whereas in the co-pending Application No. 10/450,567 the claims are directed instead to a process for manufacturing a sole for shoes. It is pointed out further that in such co-pending Application No. 10/450,567 a terminal disclaimer directed to the instant application has already been filed and accepted by the Office, hence if the instant application issues before such co-pending Application No. 10/450,567 there should be no problem with obviousness-type double patenting rejection in either application.

In view of the foregoing, allowance of pending claims 11-13, 15, 16, and 18-22 is respectfully requested.

Respectfully submitted,



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